

Remarks

A. Status of the Claims

Claims 82-83 are added, non-limiting support for which can be found in the specification at page 5, lines 4-8. No claims are amended or cancelled. Therefore, claims 39-83 are pending.

Given that new claims 82-83 are added, Applicant respectfully submits that the next office action should either be a notice of allowance or a non-final office action.

B. Obviousness Rejections

1. Examiner's Position

The Examiner has maintained the previous obviousness rejections under 35 U.S.C. § 103(a) in view of U.S. Patent 5,512,371 (“Gupta”) and U.S. Patent 6,562,466 (“Jiang”) (as to claims 39-58, 63-66, 68-70, 76, and 77) and in further view of a variety of tertiary references (as to the remaining dependent claims). Again, the rationale used by the Examiner is that it would have been obvious at the time Applicant’s invention was filed to use Jiang’s unpolished lens with the single coating process disclosed in Gupta:

It would have been obvious to a person having ordinary skill in the art to provide a fined but unpolished lens to a coating process as taught by Jiang in the method of Gupta **for the purpose of eliminating the need to first polish the lens surface.**

Action at page 3 (emphasis added). The Examiner also makes the following statement in response to Applicant’s previous arguments submitted on January 31, 2011:

Regarding Gupta, Gupta is silent on the roughness of the lens and does not teach that one must deposit a single layer coating onto a *polished* lens surface, only a lens surface in general.

Action at page 10 (emphasis in original).

2. Applicant's Response

The fact that the Examiner's stated rationale for modifying Gupta's process with Jiang's disclosure is to "eliminate[e] the need to first polish the lens surface" necessarily implies that the surface of Gupta's lens blank has, in fact, been polished. Otherwise, and according to the Examiner's own rationale, what purpose would there be to modify Gupta? Therefore, the Examiner's response to Applicant's previous arguments that Gupta merely discloses depositing a single layer onto a "lens surface in general" and not specifically "onto a *polished* lens" (see above statement) is contradictory, and the motivation/apparent reason to combine these references is erroneous. Even under *KSR*, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Intl. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007) (internal citations and quotations omitted).

Further, the Examiner also contends that Jiang fails to disclose that it is necessary to apply a multilayer coating onto Jiang's unpolished surface of the lens (Action at page 10). From this, the Examiner concludes that a person having ordinary skill in the art could have modified Gupta's process so as to deposit a single layer at the surface of an unpolished lens. Column 7, lines 55-62 (*i.e.*, Example 3) of Jiang is cited by the Examiner as support for this conclusion. This Example 3 in Jiang, however (along with Examples 1, 2, 4 and 7-10), involves the deposition of a HMC coating, the composition of which is detailed in Example 7. This HMC coating includes **three** layers (antireflection/hard coat/primer). Also, a layer of OP-21 Dymax glue is interleaved between the HMC coating and the surface of the lens. This glue layer has a thickness of less than 100 μm and preferably between 1 to 30 μm (see column 5, lines 1-3 of Jiang). The glue layer constitutes a coating.

Applicant requests the Examiner to note that a glue layer is consistently used in Jiang's disclosed process. Therefore, and according to the teachings of Jiang, at least two coating have to be applied onto the fined but unpolished surface of the lens, namely a glue layer and at least one transferred coating. Thus, the Examiner's statement at page 11 of the Office Action that "[s]ince Jiang does not teach that the coating process must be a bilayer coating, one having ordinary skill in the art would have appreciated that a single layer coating such as Gupta could be modified to coat an unpolished lens" is not tenable. The reality is that every embodiment disclosed in Jiang utilizes at least two layers to achieve its goal of coating a fined but unpolished lens substrate.

While keeping the above comments in mind, Applicant respectfully requests that the Examiner reconsider Applicant's previous arguments, which are incorporated by reference. Mainly, while the process disclosed in Jiang allows for the elimination of a polishing step of the lens, it does so only in the context of depositing at least two layers onto the surface of the unpolished lens. That is, the solution offered by Jiang to avoid the polishing step is the use of an accumulation of coatings (and not a monolayer coating), which results in the appearance of a polished lens that has not actually been polished (see data in Examples of Jiang). In particular, in order to reach the Examiner's obviousness conclusion, a person having ordinary skill in the art would actually have to ignore Jiang's solution of using multiple layers to avoid the polishing step. If Gupta is to be modified in view of Jiang's disclosure, then Applicant requests that the entire teachings of Jiang be considered, especially those teachings that are central to the rationale being used to combine these references—*i.e.*, the solution of avoiding the polishing step. The MPEP and case law require at least this much. MPEP § 2141.02 (VI) ("A prior art reference

must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention") (underline in original).

As a final note, there is simply no evidence of record to suggest that modifying Gupta's process with Jiang's process would in fact work. The reasonable conclusion based on the objective evidence of record is that a person having ordinary skill in the art would use the multi-layer coating process disclosed in Jiang if such a person desired to avoid polishing Gupta's disclosure.

Applicant requests that all of the obviousness rejections be withdrawn for at least the above-stated reasons.

C. Conclusion

Applicant believes that this case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at 512-536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



Michael R. Krawzenek

Reg. No. 51,898

Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
512.536.3020 (voice)
512.536.4598 (fax)
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